



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/636,108	08/10/2000	Erik M. Theisen	GLNPIN114873	6358

7590

10/01/2002

CHRISTENSEN O'CONNOR JOHNSON KINDNESS PLLC
Suite 2800
1420 Fifth Avenue
Seattle, WA 98101

EXAMINER

CHOW, MING

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 10/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/636,108

Applicant(s)

THEISEN ET AL.

Examiner

Ming Chow

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 2, 3, 18, 19 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The phrase “includes a voice command, digital command, and keyed command” critical or essential to the practice of the invention, but is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). On line 24-26 page 4 of specification, the applicant only discloses “the user can send voice or digital key commands directing the system to perform certain functions”. See Examiner’s Interpretation below.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 12, 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “a portion” is not clearly defined.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-3, 5, 7-11, 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Greco et al (US-PAT-NO: 5,568,540).

For claims 1 and 17, regarding section (a), Greco et al teach on item 157 Fig. 3 rewind a few seconds. The “rewind a few seconds” of Greco et al is the claimed “repositioning”. It is inherent that repositioning begins upon receipt of a command (item 157 is selected). Regarding section (b), Greco et al teach on column 5 line 51 a slider graphically shows the present position within that length. The “slider graphically shows the present position” of Greco et al is the claimed “feedback”. The “slider” of Greco et al is the claimed “supervisory signal”. Regarding section (c), Greco et al teach on item 155 Fig. 3 stop.

Art Unit: 2645

Regarding claims 2 and 18, Greco et al teach on item 157 Fig. 3 “digital command” (window-based command selection).

Regarding claims 3 and 19, Greco et al teach on item 155 Fig. 3 “digital command” (window-based command selection).

Regarding claims 5 and 21, Greco et al teach on items 148 and 149 Fig. 3 “a visual signal”.

Regarding claims 7 and 23, Greco et al teach on column 6 line 31 the user must play back the message and stop it at the desired point to know how the slider position corresponds with an interval between words within a message. It is inherent that the slider must reposition (on a computer) operates at fixed intervals (in terms of number of bits or bytes).

Regarding claims 8 and 24, Greco et al teach on column 5 line 52 “by using the mouse to move the slider, the user may start playing the message at any point”. The “at any point” of Greco et al reads on the claimed “at variable intervals”.

Regarding claims 9 and 25, Greco et al teach on item 156 Fig 3 “rewind to the beginning”. The “rewind to the beginning” of Greco et al reads on the claimed “based on the length of the voice message”.

Art Unit: 2645

Regarding claims 10 and 26, Greco et al teach on column 6 line 31 the user must play back the message and stop it at the desired point to know how the slider position corresponds with an interval between words within a message. The “desired point” of Greco et al reads on the claimed “based on the position of the voice message”.

Regarding claims 11 and 27, Greco et al teach on item 159 Fig. 3 “forward to the end”. The “forward to the end” of Greco et al is the claimed “fast-forwarding”.

Regarding claims 14 and 30, Greco et al teaches on item 156 Fig. 3 “rewind to the beginning”.

Regarding claims 15 and 31, it is inherent that Greco’s system must stop the repositioning at the beginning of the message. Greco et al also teach on items 152, 150, and 151 of Fig. 3. “From”, “To”, “Subject”, and “Sent”. The “From”, “To”, “Subject”, and “Sent” are the contents of the message envelope. The message envelope is displayed (the claimed “playing”) when the message is rewinding and before the beginning (the claimed playing the message) of message is reached.

Regarding claims 16 and 32, Greco et al teach on item 148 Fig.3 “a slider”. The “slider” of Greco et al is the claimed (visual) signal. When the slider reaches the beginning (the left most position of item 149 Fig. 3 bar graph) it provides a signal that the beginning of the message has been reached.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greco et al as applied to claim 1 above, and in view of Knuth et al (US-PAT-NO: 5,406,618). Greco et al failed to teach the supervisory signal is an aural signal. However, Knuth et al teach on column 4 line 39 "I will play your messages". The "I will play your messages" of Knuth et al is the claimed aural signal. It would have been obvious to one skilled at the time the invention was made to modify Greco et al to have the supervisory signal is an aural signal as taught by Knuth et al such that the modified system of Greco et al would be able to support the aural signal to the system users.

5. Claims 6 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greco et al as applied to claim 1 above, and in view of Carson (US-PAT-NO: 6,232,887). Greco et al failed to teach the supervisory signal is a vibratory signal. However, Carson teaches on column 9 line 4 a vibrating signal. It would have been obvious to one skilled at the time the invention was made to modify Greco et al to have the supervisory signal is a vibratory signal as taught by

Art Unit: 2645

Carson such that the modified system of Greco et al would be able to support the vibratory signal to the system users.

6. Claims 12 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greco et al as applied to claim 11 above, and in view of Fielder (US-PAT-NO: 5,845,240). Regarding the steps of stopping the repositioning substantially at the end of the message. It is inherent that Greco's system must stop at the end of the message. Greco et al failed to teach playing a portion of the message substantially preceding the end. However, Fielder teaches on column 8 line 32 "plays fast-forward through the current block". The "plays" of Fielder reads on the claimed "playing a portion". It would have been obvious to one skilled at the time the invention was made to modify Greco et al to have the playing a portion of the message substantially preceding the end as taught by Fielder such that the modified system of Greco et al would be able to support the playing a portion of the message to the system users.

7. Claims 13 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greco and Fielder et al as applied to claim 12 above, and in view of Ireton (US-PAT-NO: 5,970,447). Greco et al failed to teach the steps of providing a signal that the end of the message has been reached. However, Ireton teaches on column 1 line 21 "end of message signal". The "end of message signal" of Ireton reads on the claimed "providing a signal that the end of the message has been reached". It would have been obvious to one skilled at the time the invention was made to modify Greco and Fielder to have the providing a signal that the end of the message has been

Art Unit: 2645

reached as taught by Ireton such that the modified system of Greco and Fielder would be able to support the signal to the system users.

Examiner's Interpretation

8. The examiner interprets claims 2 and 3 to be "The method of Claim 1, and includes one of a voice command, digital command, and keyed command".

Conclusion

9. The prior art made of record and not replied upon is considered pertinent to applicant's disclosure.

- Miner et al (US-PAT-NO: 6,021,181) teach electronic voice mail message handling system.

10. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or

Application/Control Number: 09/636,108

Page 9

Art Unit: 2645

proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to TC2600's Customer Service FAX Number 703-872-9314.

Patent Examiner

Art Unit 2645

Ming Chow



FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

